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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,924	01/06/2004	Dane Scarborough	LEVL106	5707
7590 10/26/2004				
STEPHEN M. NIPPER DYKAS, SHAVER & NIPPER, L.L.P P.O. BOX 877 BOISE, ID 83701		EXAMINER BENNETT, GEORGE B		
		ART UNIT PAPER NUMBER		
		2859		

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/753,924	Applicant(s) SCARBOROUGH, DANE	
	Examiner G. Bradley Bennett	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 8 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kobayashi.

3. Kobayashi discloses a housing **8**, a tape measure **18** and a marking portion **26** which extends perpendicularly from the bottom portion **12** of the housing. The marker may be made as an integral part of the housing (col. 2, ll. 46-51) or a lug that is welded to the housing or otherwise attached (col. 2, ll. 35-38). If the marker is an integral part of the casing of a predetermined shape (col. 2, ll. 47-48), it is inherently the same material as the housing. If it is welded to the housing, it is inherently removable. Likewise, the marks made by the Kobayashi device are inherently removable, since scratches may be "buffed out" or otherwise removed from a surface.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2859

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Hollingsworth.

6. Kobayashi discloses the invention substantially as claimed. However, Kobayashi does not disclose that the housing is magnesium. Hollingsworth discloses that it is known to use magnesium for the purpose of forming a housing around a tool (col. 3, ll. 36-37). Therefore, it would have been obvious at the time the invention was made for one of ordinary skill in the art to use magnesium as taught by Hollingsworth for the purpose of forming a housing around the tape of Kobayashi.

7. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Carlson.

8. Kobayashi discloses the invention substantially as claimed. However, Kobayashi does not disclose that the marking portion is extended downwards from a position forward of the junction between the base portion and the front portion as claimed. Carlson discloses that it is known to place the marking portion in a position extending downwards from a position forward of the junction between the base portion and the front portion for the purpose making marks that correspond to a specific orientation of the tape. Therefore, it would have been obvious at the time the invention was made for one of ordinary skill in the art to use a marking portion configuration as taught by Carlson in conjunction with the device of Kobayashi for the purpose of providing an alternative marking location on the Kobayashi device.

9. Claims 7, 11, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Bo.

10. Kobayashi discloses the invention substantially as claimed. However, Kobayashi does not disclose that the marking portion is convex as claimed. Bo discloses that it is known to make the shape of markers concave or convex for the purpose of marking a piece of work (col. 3, ll. 43-46). Therefore, it would have been obvious at the time the invention was made for one of ordinary skill in the art to use a convex marker as taught by Bo in conjunction with the device of Kobayashi for the purpose of providing an alternative marking shape on the Kobayashi device.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi and Bo as applied to claim 13 above, and further in view of Hollingsworth.

12. Kobayashi and Bo disclose the invention substantially as claimed. However, neither Kobayashi nor Bo discloses that the housing is magnesium. Hollingsworth discloses that it is known to use magnesium for the purpose of forming a housing around a tool (col. 3, ll. 36-37). Therefore, it would have been obvious at the time the invention was made for one of ordinary skill in the art to use magnesium as taught by Hollingsworth for the purpose of forming a housing around the combination as taught by Kobayashi and Bo.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi and Bo as applied to claim 13 above, and further in view of Carlson.

14. Kobayashi and Bo disclose the invention substantially as claimed. However, neither Kobayashi nor Bo discloses that the marking portion is extended downwards

Art Unit: 2859

from a position forward of the junction between the base portion and the front portion as claimed. Carlson discloses that it is known to place the marking portion in a position extending downwards from a position forward of the junction between the base portion and the front portion for the purpose making marks that correspond to a specific orientation of the tape. Therefore, it would have been obvious at the time the invention was made for one of ordinary skill in the art to use the marker configuration as taught by Carlson for the purpose of providing an alternative marking location on the combination as taught by Kobayashi and Bo.


15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to G. Bradley Bennett whose telephone number is 571.272.2237. The examiner can normally be reached on M-TH 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on 571.272.2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2859

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


G. Bradley Bennett
Primary Examiner
Art Unit 2859

gbb
25 OCT 2004